



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/591,366	06/09/00	BAIDYA	N 421452000100

GLADYS H MONROY  
MORRISON & FOERSTER LLP  
755 PAGE MILL RD  
943041018 PALO ALTOLE IN DATABASE  
ITALY

HM12/1017

EXAMINER

OGIHARA, N

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

10/17/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/591,366

Applicant(s)

BAIDYA ET AL.

Examiner

Nancy Ogihara

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-48 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-23 and 32-37, drawn to an array comprising a plurality of polynucleotide probes immobilized on a solid support and method of preparing, classified in class 536, subclass 24.3. If this group is elected, a species election is required for the polynucleotide.
- II. Claims 24-31, 47, and 48, drawn to a method for detecting gene transcripts, classified in class 435, subclass 6. If this group is elected, a species election is required for the polynucleotide.
- III. Claims 38-43, drawn to a machine readable storage medium, classified in class 395, subclass 821. If this group is elected, a species election is required for the polynucleotide.
- IV. Claims 44-46, drawn to a computer based system for detecting differential expression of a multiplicity of gene transcripts, classified in class 395, subclass 82163. If this group is elected, a species election is required for the polynucleotide.

### **Sequence Election Requirement for all Groups**

Groups I-IV detailed above, read on patentably distinct sequences. Each sequence is patentably distinct because they are unrelated sequences, and further restriction is applied. For the Group elected, Applicant must elect a polynucleotide to initiate examination. If the selected sequence is found to be free of the prior art, search of the remaining sequences will continue.

Groups (I and II) are separate and distinct from Groups (III and IV) because Groups (I and II) are drawn to chemical compounds, whereas Groups III and IV are drawn to a computer and computer-related components. Groups I-II are involved in biological systems and biochemical reactions, whereas the computer system of Groups III and IV is not related to the chemical compounds of Groups I and II. As such the Inventions would require searching in separate and non-overlapping areas, imposing an undue search burden upon the examiner if not restricted.

Groups I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotide array can be used to detect polymorphisms.

Groups III and IV are separate and distinct as Group IV encompasses hardware components (e.g. search device and retrieval device) not required or encompassed by the storage medium of Group III. As such the Inventions would require searching in separate and non-overlapping areas, imposing an undue search burden upon the examiner if not restricted.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

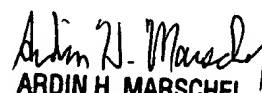
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy Ogihara whose telephone number is (703) 308-9363. The examiner can be reached Monday-Friday from 8:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Michael Woodward can be reached at (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist, whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 1631 by facsimile transmission. Papers should be faxed to Group 1631 via the PTO Fax Center located in Crystal Park I. The faxing of such papers must conform with the notice published in the Official Gazette 1096 OG 30 (November 15, 1989). The CMI Fax Center number is (703) 308-4242.

Nancy Ogihara  
October 11, 2000

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER